IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re App. No.:	09/449,021	)	PATENT APPLICATION
Filing Date:	11/24/1999	)	Art Unit: 2192
Inventor:	Emmelmann	)	Examiner: C. Kendall
Title:	*Interactive Server Side Components*	)	Customer No.: 8665

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)

Dear Sir:

In response to the Determination of Patent Term Adjustment included with the Notice of Allowance dated October 18, 2012, applicant respectfully requests reconsideration based on the Remarks below.

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)

Applicant appreciates the Notice of Allowance dated October 18, 2012. The Patent Term Adjustment accorded to this application in the Notice of Allowance was 1145 days, and applicant complains that such a determination is not sufficient in light of applicable rules and the prosecution history of this application, which has now been pending for over 13 years, including 4 notices of appeal, 3 appeal briefs filed, a pre-appeal conference, and a successful appeal. In applicant's view, the lengthy application pendency was caused in large part by the PTO's withdrawal of the application from issue in 2008 upon the insistence of quality assurance, based primarily on art that was cited by applicant early in the examination of this application.

It also appears to applicant that revised rules for PTA calculation, effective September 17, 2012, were not applied in the current PTA calculation shown on PAIR.[1]

Reconsideration of the Patent Term Adjustment is respectfully requested in light of the discussion below.

Applicant notes that two factors create uncertainty in the PTA calculation, as set forth below, namely, the application of Patent Rule 704(c) [37 CFR § 1.704(c)] in calculating applicant delay, and the method for calculating B delay.

1. BACKGROUND

The patent application was originally filed on November 24, 1999, with a priority claim to two provisional applications filed in November 1998. Since a request for continued prosecution (CPA) was filed by applicant in 2002, the grounds for adjustment of patent term are set forth in 37 C.F.R. § 1.701 *et seq.*, and the PTO calculation shown on PAIR indicates that the application is entitled to 1145 days of term extension.

The rejections of the claims at issue were first appealed in September 2005, but the case returned to prosecution briefly, before the notice of appeal was re-filed in September 2006,

[1] Recent amendments to the Patent Rule 703 (see 77 Fed. Reg. 49354 (2012) are applicable in this case since a Notice of Allowance was issued after September 17, 2012. The recent amendments to Rule 704 are not applicable in this case since the last Appeal Brief was filed before September 17, 2012.

along with a request for a pre-appeal review. The decision on pre-appeal review 10 months later returned the case to prosecution, but ultimately led to a notice of allowance in April 2008. The application was withdrawn from issue in July 2008, apparently due to random quality review, and the Examiner thereafter issued a rejection based in part on art first cited by applicant very early in the prosecution. Applicant again appealed in February 2010, and the Board of Appeals finally reversed the Examiner on all pending claims in February 2012. A Notice of Allowance soon followed.

2. SUMMARY OF DIFFERENCES FROM PAIR CALCULATION

The prosecution history of this case is extraordinary long, which unfortunately also makes the calculation for term adjustment long and complex as well. Applicant disagrees with some of the calculations as shown on PAIR, as listed below and described in more detail in section 3. Applicant therefore respectfully requests reconsideration and recalculation of the patent term adjustment for this application.

1. With respect to item 91 dated 10-5-2007, applicant submits that the "miscellaneous communication" is not an action under section 132 or an allowance, and therefore does not signify the end of a period of delay by the PTO.

2. With respect to item 107 dated 4-15-2008 (Notice of Allowance), applicant believes the calculation of 41 days of PTO delay is in error, as the Notice was subsequently withdrawn by the PTO.

3. With respect to item 115 (non-final rejection), applicant believes that a PTO delay of 613 days should be associated with this item.

4. With respect to item 122 (notice of appeal), applicant is not sure if an applicant delay of **3** days should be associated with this item.

5. With respect to item 127 (RCE), applicant is not sure if an applicant delay of **18** days should be associated with this item.

6. With respect to item 136 dated 07-01-2009, applicant thinks that possibly the PTO delay is 62 days instead of 83 days, as measured from the filing of an RCE on 12-30-2008.

7. With regard to item 154 dated 8-6-2010 (IDS), applicant believes that no applicant delay should be associated with this item.

8. With respect to item 188 dated 9-27-2011 (errata sheet) **15** days of applicant delay under § 1.704(c)(8) should be associated with this item.

9. With respect to item 208 dated 2-24-2012 (Board decision), applicant believes that the revised rule effective 9-17-2012 dictates that the C delay associated with this item is now 438 days, rather than 743 days as indicated on PAIR.

10. The PAIR calculation shows 0 days overlap between A and B delays and between A and C delays. Applicant believes there is overlap in both cases, as discussed below.

11. The revised Rule 703 for patent term adjustments, effective 9-17-2012, is applied by applicant below, but does not appear to have been applied to the calculation as shown on PAIR.

3. DETAILED DISCUSSION/CALCULATION OF ADJUSTMENTS

In accord with 35 USC § 154(b), a patent applicant is provided with a day for day adjustment to increase the patent term if:

(A) the PTO fails to act promptly, i.e., by issuing a first action (or allowance) more than 14 months after the application filing date, or by issuing a subsequent action more than 4 months after an applicant response (an "A" type delay);

(B) the application is pending for more than 3 years (a "B" type delay); and

(C) further delay results from a successful appeal (a "C" type delay).

To the extent that these PTO delays overlap, the number of days awarded to applicant as an adjustment shall not be more than the actual number of days of delay.

Any applicant delay, e.g., responding more than 3 months after an official action, results in a day for day adjustment to decrease the patent term.

Attached are: Exhibit A, which is a spreadsheet showing the patent term adjustment calculation as reported on PAIR; and Exhibit B, which is a spreadsheet showing the patent term adjustment calculation as performed by applicant.

A. A Delays – Applicant's Calculation

Adjustments are provided for "A" type delays, which result from a failure of the PTO to act promptly, as specified in the Patent Laws at 35 U.S.C. § 154(b)(1)(A), and the Patent Rules at 37 C.F.R. §§ 702(a) and 703(a). Applicant submits that the following properly describes all such instances of PTO "A" delays during prosecution of this application:

(i) On June 6, 2005, the PTO mailed a final rejection more than 4 months after applicant's response was filed on January 18, 2005, resulting in a PTO delay of ***19 days*** (5/18/2005 to 6/6/2005), as posted on PAIR.

(ii) On June 15, 2006, the PTO mailed a non-final rejection more than 4 months after applicant's appeal brief was filed on February 13, 2006, resulting in a PTO delay of ***2 days*** (6/13/2006 to 6/15/2006), as posted on PAIR.

(iii) On September 17, 2008, the PTO mailed a non-final rejection more than 4 months after applicant filed a Pre-Brief Conference Request along with a Notice of Appeal on September 13, 2006. This resulted in a PTO delay of ***613 days*** (1/13/2007 to 9/17/2008).

Although the filing of an appeal brief would ordinarily shift the burden of response to the PTO under Rule 703, in this instance, the filing of the Pre-Brief Conference Request immediately shifted the burden of response to the PTO. In particular, the applicant's obligation to file the appeal brief was suspended pending the decision on Pre-Appeal Review. Further, the decision in this case was to return to prosecution and wait for an office action. This situation is not explicitly covered in the rules or comments, but it should be clear that the 4 month requirement for PTO responses should still apply following applicant's Request for Pre-Appeal Review. Any delay at this point is clearly attributable to the PTO's failure to act.

The PTO did mail a "Miscellaneous Communication" on October 5, 2007, but as discussed in Section A.1 below, this action was not a proper action and does not serve to end the delay period.

Another factor to consider for this item (iii) is that the PTO mailed a Notice of Allowance on April 15, 2008. In a strict interpretation of the rules, this action might stop the clock for item (iii), resulting in a minimum PTO delay of 458 days. However, this Notice of Allowance was subsequently withdrawn by the PTO on July 9, 2008, and the new rejection not mailed until September 17, 2008. Applicant submits that the withdrawal of the Notice of Allowance constitutes further PTO delay, negating the issuance of the Notice and negating the prior end of the relevant period of A delay, which thus continued until the PTO issued the rejection on September 17, 2008, a total delay of 613 days added to prosecution as a result of PTO delay.

(iv) On July 1, 2009, the PTO mailed a non-final office action more than 4 months after applicant's response on December 9, 2008, resulting in a PTO delay of 83 days according to PAIR. However, since applicant also filed an RCE including a response on December 30, 2008, applicant is not sure if the delay needs to be calculated from the December 9th response

filing or the December 30th RCE filing and/or whether the December 30th RCE and response are to be seen as other papers creating applicant delay according to Rule 704(c)(8) as discussed in section D below. In an abundance of caution, applicant herein measures the A delay based on the December 30th RCE filing, which results in a delay of ***62 days*** (4/30/2009 to 7/1/2009), but seeks the guidance of the PTO on this issue.

(v) On October 13, 2010, the PTO mailed an Answer to applicant's appeal brief, more than 4 months after the appeal brief was filed. This resulted in a PTO delay of 4 days. However, on July 12, 2011, the PTO mailed another Answer, stating new grounds of rejection based on art that was known prior to the appeal. This resulted in an actual PTO delay of ***276 days*** as measured from the date that the appeal brief was filed (10/09/2010 to 7/12/2011).

The total of all A delays described in items (i) through (v) above is ***972 days***.

1. *Errors in the PTA Calculation Shown on PAIR*

(i) Item #91 ("Mail Miscellaneous Communication to Applicant", October 05, 2007) indicates a PTO delay of 265 days associated with this "miscellaneous communication," which is the period measured from 4 months after applicant's filing of the Appeal Brief and Request for Pre-Appeal Review on September 13, 2006. However, this calculation is in error. The referenced item #91 is a Notice of Non-Compliant Amendment, but it references an informal document with proposed amendments submitted by fax only on July 20, 2007. Applicant did not file any formal response or amendment, as clearly indicated on the document. Therefore, the Notice was not a proper action and cannot be the basis or end-point for measuring an A delay associated with the item. This conclusion is supported by other prosecution events.

For example, on July 2, 2007, the PTO issued a decision in the Pre-Appeal Review, which stated: "*Reopen Prosecution – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.*" No PTO delay is associated with this specific item since it is not one of the PTO actions described in the rules. However, the next official action by the PTO was the mailing of the Notice of Allowance of April 15, 2008 (and even this was subsequently withdrawn).

Despite the lack of a substantive rejection or other official action following the decision on Pre-Appeal Review, the Examiner and applicant engaged in ongoing discussions regarding the claims, which are reflected on the record. Thus, on July 20, 2007, at the request of the Examiner, the applicant faxed to the Examiner ***proposed*** amendments to the independent

claims (item #86), and not a formal response or amendment under section 111 or section 113. This is reflected in applicant's summary of interviews filed on July 31, 2007. The subsequent Notice of Non-Compliant Amendment is therefore not a proper action under section 132 since there was no response or amendment by applicant.

(ii) On November 5, 2007, still in response to ongoing discussions with the examiner and in response to the Notice of Non-Compliant Amendment, applicant submitted ***proposed*** amendments to all the claims (item #92), and not just the independent claims. In the remarks accompanying these proposed amendments, applicant complained that he had never received an office action as promised in the pre-appeal review decision. Nevertheless, the proposed amendment was still not a formal response or amendment under section 111 or section 113, since there was no pending office action to respond to, and since the amendment on its face was merely "proposed" and not an official response or amendment. In fact, the Examiner ultimately sought and received authorization by telephone from the undersigned on January 28, 2008, to enter the proposed amendments, as documented in the Notice of Allowance mailed April 15, 2008.

Item #92 is incorrectly characterized on PAIR as a "*Response after Non-Final Action.*" However, as noted above, this was merely an informal proposed amendment and was considered informal by the examiner as well.

(iii) Item #107 ("Mail Notice of Allowance") indicates a PTO delay of 41 days as measured from item #92. However, as discussed above, item #92 was not an official response by applicant, and therefore the basis for this calculation is in error. Also, as discussed above, the Notice of Allowance was withdrawn and should therefore not be considered in the PTA calculation.

B. *B Delay – Applicant's Calculation*

Adjustments are provided for "B" type delays, which result from a failure of the PTO to issue a patent within 3 years of the actual filing date, as specified in the Patent Laws at 35 U.S.C. § 154(b)(1)(B), and the Patent Rules at 37 C.F.R. §§ 702(b) and 703(b), including recent revisions to § 703. Although the PTO normally calculates the B delay when the issue notification letter is generated, there are several issues regarding the calculation of B delay that merit discussion herein, as follows.

1. *Probable Errors in the PTO Calculation of B delay*

(i) In 2005-2006, applicant twice filed notices of appeal, but in both instances, these appeals were returned to prosecution and a reply brief was not filed. Therefore, under the new rules effective September 17, 2012, B delay should continue to accumulate during that time.

(ii) Applicant's filing of an RCE on December 30, 2008 will likely be construed by the PTO to cut off any further B delay, resulting in a total B delay to that date of ***1137 days***. However, several factors dictate otherwise: (1) extraordinary circumstances led to the RCE filing; (2) the plain language of § 154 (b)(1)B(i) states that the patent term guarantee does not include "*any time consumed by continued examination of the application requested by the applicant under section 132 (b)*" and applicant believes that the "*time consumed by continued examination*" is not correctly calculated by simply cutting off B delay; (3) the plain language of § 154, as supported by the *Exelixis* decision, does not require cutting off the B delay more than 3 years after the PTO had already failed in its guarantee (i.e., more than 6 years after the relevant filing date).

A proposed change to the rules for appeal briefs was scheduled to take effect on December 10, 2008. Thus, on December 9, 2008, in order to maintain the applicability of the existing rules for appeal briefs, applicant did two things. First, applicant *e*-filed a response (item #120) to the outstanding office action, but also filed a Notice of Appeal (item #122) and Appeal Brief (item #123) using the certificate of mailing procedure. (Thus, item #120 is dated 12/9/08 while item #122 is dated 12/12/2008). The filing of a response to office action was intended to get amendments entered in order to better position the claims for appeal and to remove some of the limitations that were grudgingly made to obtain the Notice of Allowance before it was withdrawn. The appeal brief filing was intended to avoid the scheduled change in rules and maintain the applicability of existing rules regarding construction of appeal briefs, in particular, since applicant had already worked extensively on appeal briefing for nearly 3 years by this point. Applicant was especially worried about new content requirements paired with a new 30 page limit for appeal briefs, since the brief filed on December 12th had 44 pages excluding the appendix and table of contents. On this issue, Applicant would have been required to petition for submitting a longer brief under the new rules without any guarantee that such a petition would be granted, and if not, significant work would be required to reduce

the length of the brief, including the possibility that some arguments would be left out of the brief.

However, on December 10, 2008 (the scheduled effective date for the new rule), the PTO issued a notice delaying implementation of the rule change (see attached Exhibit C). Thus, applicant's concerns became moot, and it was deemed more effective to continue prosecution in order to have all amendments entered and considered, thus leading to applicant's RCE filing on December 30, 2008. Applicant would not have appealed at that time except for the proposed rule change, and should not be penalized for using the procedural tool of an RCE to withdraw the appeal. Applicant notes that, possibly due to the RCE, the office action that followed the RCE on July 1, 2009 was non-final. However, at the time the appeal was filed on December 12, 2008, there was an outstanding non-final rejection dated September 17, 2008, and as a matter for right, applicant would have been permitted to get his amendments entered anyway.

The PTO could and should have published the suspension of the proposed new rules earlier than the day they were to take effect, and applicant would not have taken all of the actions it did in December 2008. Alternatively, the PTO could have allowed applicant to simply withdraw the December 12, 2008 Notice of Appeal without the need for an RCE.

For these reasons, applicant submits that the PTO should not consider the December 30, 2008 RCE as an end point for purposes of PTA, which would result in a B delay of ***2056 days*** calculated from the end of the 3 years period on November 19, 2005 to the second RCE on September 17, 2012 making 2494 days, excluding the time under appeal of 438 days.

(iii) Even if the PTO continues to construe 35 USC § 154 as dictating that B delays are cut off by applicant's RCE filing on December 30, 2008, applicant believes that the time used for appeal briefing is not primarily "*time consumed by continued examination,*" but instead, time caused by a wrong determination of the examiner. Thus, applicant submits the actual time consumed by continued examination (in the sense of § 154(b)(1)B(i)) is at most the time from filing the first RCE on December 30, 2008, up to the time of filing the Notice of Appeal on February 12, 2010.

Part of the appeal briefing and the period of time from the Board decision on February 24, 2012, up until the filing of the second RCE on September 17, 2012, would have occurred anyway and is not specifically attributed to the first RCE. Therefore, applicant submits additional B delay should be provided from the date of filing the Notice of Appeal on February

12, 2010, up to the filing of applicant's Reply Brief on December 13, 2010, a total of ***304 days***, and from the date of the Board decision on February 24, 2012, up to the date of the second RCE on September 17, 2012, a total of ***206 days*** resulting in a total B delay of at least ***1647 days***.

Lastly, the period of time from the date the payment of the issue fee in January 2013 is due up to issuance of the patent is also not time consumed by continued examination of the application because this time would have been required independently of both RCEs, and should therefore be compensated with additional B delay.

2. *The Exelixis Case*

A recent opinion out of the Eastern District of Virginia held that the PTO has not been calculating B delay properly. More specifically, the plain language of 35 U.S.C. § 154(b)(1)(B) relating to patent term guarantees excludes time consumed by any of 3 tolling events (such as an RCE) that occur ***during*** the 3 year period, not ***after***. *See Exelixis, Inc. v. Kappos*, 2012 U.S. Dist. LEXIS 157762 (E.D. Va. 2012). This holding is apparently contrary to the PTO's application of 37 CFR 1.703(b)(1), which the PTO interprets as cutting off any B further delay after applicant files an RCE, regardless of when the RCE is filed. Applicant disagrees with the PTO's application of this rule, and believes that B delay should continue to accrue after the 3 year threshold until issuance in accord with the plain language of the statute. On this basis, applicant believes that the B delay accrued thus far from November 19, 2005 (3 years after filing date) to January 1, 2013 is ***2600 days***, and is continuing to accrue, as shown on Exhibit B. Note that these 2600 days of delay includes the time under appeal after the 3 year period as the Exelixis decision implies, however, if applicant's interpretation is correct, then overlap between B delay and C delay should be taken into account, as discussed below.

C. *C Delay*

Adjustments are provided for "C" type delays, which in this case result from the delay due to the successful appeal. According to recently revised Rule 703(e), *see* 77 Fed. Reg 49354 (2012), this is defined as the number of days beginning with the filing of the Reply Brief by applicant and ending on the date of the Board decision in favor of applicant. Applicant filed its first Reply Brief (item #167) on December 13, 2010, and on February 24. 2012, the BPAI issued a final decision reversing the examiner, for a total of ***438 days***. Applicant notes that this

number is 305 days less the calculated delay before the rule change. Therefore, applicant believes the rule change does not meet one of the objectives of 35 USC § 154, which is to compensate applicant for the time lost to appeal when the adverse decision of the Examiner is reversed, as here. This lost time should include the time for writing the briefs. Further, the first RCE was filed in the special situation described above to withdraw an appeal, but this action may have the unintended result of no B delay accruing during the appellate review. Therefore the reduction of class C delay from 743 days to 438 days indeed does not fully compensate applicant for the time lost due to the appellate review.

D. *Applicant Delay*

(i) On July 31, 2003, applicant filed a response more than 3 months after the corresponding office action, resulting in an applicant delay of ***64 days***, as posted on PAIR.

(ii) On April 30, 2004, applicant filed a response more than 3 months after the corresponding office action, resulting in an applicant delay of ***94 days***, as posted on PAIR.

(iii) On January 18, 2005, applicant filed a response more than 3 months after the corresponding office action, resulting in an applicant delay of ***66 days***, as posted on PAIR.

(iv) On September 8, 2005, applicant filed a notice of appeal more than 3 months after the corresponding office action, resulting in an applicant delay of ***2 days***, as posted on PAIR.

(v) Other applicant delays might be applied in accord with Patent Rule 704(c), but it is unclear to applicant how or when this rule is applied. For example, on January 3, 2007, applicant filed a request for status of the application; on January 5, 2007, applicant filed a power of attorney; on June 6, 2007, applicant filed a summary of examiner interview; on July 20, 2007, applicant faxed proposed amendments to the examiner (and re-faxed these amendments on August 6, 2007); on July 31, 2007, applicant filed another summary of examiner interview; on January 30, 2008, applicant faxed a letter to the supervisory examiner discussing newly discovered prior art; and on November 16, 2009 applicant filed another summary of examiner interview.

As another example, on December 12, 2008, the PTO received applicant's Notice of Appeal and Appeal Brief, 3 days after applicant filed a response to office action, and under Rule 704(c)(8), this may result in an applicant delay of ***3 days***. On December 30, 2008, 18 days later, applicant filed an RCE, possibly resulting in an additional applicant delay of ***18 days*** under Rule 704(c)(8).

On June 9, 2010 Applicant filed an appeal brief after filing a defective brief on May 12, 2010. Under the new rule effective September 17th, 2012, this item does not result in an applicant delay because the corresponding notice of appeal was filed before September 17th, 2012.

On September 13, 2011, applicant filed a petition, one day after filing a second reply brief. Under Rule 704(c)(8), this may account for another day of applicant's delay.

On September 27, 2011, applicant filed an errata sheet for appellants' second reply brief, which was filed on September 12, 2011, and therefore this item may account for another ***15 days*** of applicant delay.

On October 11, 2011, applicant filed an applicant summary of interview with examiner, which may account for additional applicant delay.

On May 23, 2012, shortly before a Notice of Allowance, and November 19, 2012, shortly after another Notice of Allowance, applicant filed further IDS's, which may be considered further applicant delay. Applicant notes that the IDS filed on November 19th cited art that had been revealed in related case 13/345,513 less than 30 days before. A supplemental Notice of Allowance has not been issued (so far).

The total of all applicant delays described above is ***262 days***.

1. *Errors in the PTA Calculation Shown on PAIR*

Regarding item 154 (IDS), the calculation on PAIR assigns an applicant delay of 58 days to this item, presumably under Rule 704(c)(8). However, applicant disagrees. On the face of the IDS, applicant indicated that it was not compliant with Rule 97, and applicant simply requested that the IDS be placed into the application file but not considered by the PTO. There was no need to delay or restart consideration of the appeal brief on the basis of a non-compliant IDS that was not required to be considered, as in this case, and therefore no applicant delay should be associated with this item. Various other IDS were filed during appeal on April 12, 2011, April 15, 2011, April 18,2011, and October 11, 2011, however, after filing the reply brief, and no applicant delays are or should be associated with these items.

E. *Overlapping Delays*

Since B delay is properly calculated as continuing from November 19, 2005 until patent issuance if the rationale of the *Exelixis* case is applied, all but 19 days of the A delay overlaps

with the B delay, i.e., the overlap between A delays and B delays is 972-19 = ***953 days***. Likewise, under this rationale, the 438 days of C delay completely overlaps with B delay.

If, however, the rationale of the *Exelixis* decision is not applied by the PTO, and the B delay is cut off on applicant's filing the RCE on December 30, 2008, then the overlap of A and B delay is 2+613 days = 615 days.

If the B-delay is cut after the second RCE then there is a A/B overlap of 2+613+62+65 = 742 days, whereby 65 is part of PAIR item 183 before December 13, 2010.

The overlap between A delays and C delays is ***211 days***, measured from applicant's filing of a Reply Brief on December 13, 2010, up until the Examiner's Answer filed on July 12, 2011. If the rationale of the *Exelixis* case is applied these 211 days also overlap with B delay resulting in a A/B/C overlap of 211 days.

F. *PTO Manual Adjustments*

(i) In applicant calculation of 613 days of A delay in section 3.A(iii) above, it was noted that the Patent Rules do not explicitly cover the scenario presented in this case, and thus the PTO could make additional manual adjustments in order to fully compensate application for delays associated with prosecution and appeal of this application.

(ii) Applicant notes that a significant portion of the delay in this case comes from the fact that it was withdrawn from issue in 2008 after 9 years of prosecution, apparently by quality assurance review, primarily on the basis of art that was presented to the examiner early during prosecution. Applicant believes that if this art had been properly considered and discussed earlier, prosecution would have been resolved significantly faster. Thus, applicant asks for favorable consideration and manual adjustment to increase the PTA to compensate for delays that are clearly attributable to PTO actions.

G. *PTA Calculation*

In light of the remarks above, applicant believes the following describes the PTA to which applicant is entitled:

First, applicant believes that the rationale of the *Exelixis* decision should be applied to this case as discussed in section 3.B.2 above, as shown in column B-3 on Exhibit B and in the table below, and notes that other court cases have been recently filed against the PTO challenging its methods of calculating the period of B delay. However, since the PTO

apparently did appeal the *Exelixis* decision, and applicant recognizes that other outcomes are possible, as discussed above. Therefore, applicant herewith provides other plausible calculations in the event the PTO determination of PTA is aligned with one of these alternative methods.

For example, as reasoned in section 3.B above, applicant submits that the first RCE filed in December 2008 should not be counted for PTA purposes because of the very special situation associated with this RCE filing. Column B-2 in the table below shows this scenario. Lastly, if the first RCE is deemed to cut off the B delay, then column B-1 shows this scenario.

	B-1	B-2	B-3
Category	Cutting off B-delay after first RCE	Cutting off B-Delay after second RCE	Under rationale of *Exelixis* Decision
A delays	972	972	972
B delays	1137	2056	2600+
C delays	438	438	438
A/B overlap	615	742	953
A/C overlap	211	211	211
B/C overlap			438
A/B/C overlap			211
Applicant delays	262	262	262
PTO Adjustment	??		??
Total	1459	2251	2357

G.1 Calculation cutting off B delays after first RCE

If the rationale of the *Exelixis* decision is not applied and B delay is cut after the first RCE in December 2008 (see column B-1 above), the PTA calculation is:

total PTA = (A delays +B delays +C delays) - (overlapping A/B delays + overlapping A/C delays) - (applicant delay) +/- PTO Manual Adjustments:

= (972+1137+438) – (615+211) – 262

PTA = ***at least 1459 days***

G.2 Calculation cutting off B delays after second RCE

If the rationale of the *Exelixis* decision is not applied and B delay is cut after the second RCE in September 2012 (see column B-2 above), the PTA calculation is:

total PTA = (A delays +B delays +C delays) - (overlapping A/B delays + overlapping A/C delays) - (applicant delay) +/- PTO Manual Adjustments:

= (972+2056+438) – (742+211) – 262

PTA = ***at least 2251 days***

G.3 Calculation under the rationale of the Exelixis decision

Under the rationale of the *Exelixis* decision, the PTA calculation is complicated by the fact that the Exelixis decision implies that B delay continues to accumulate during appeal as discussed above. However this means that the B/C overlap must be considered as well. Applicant believes that the following formula takes this into account.

total PTA = (A delays +B delays - overlapping B/C delays +C delays) - (overlapping A/B delays – overlapping A/B/C delays + overlapping A/C delays) - (applicant delay) +/- PTO Manual Adjustments.

Up to January 1, 2013 under the *Exelixis* decision and using the above formulation, the calculation is:

PTA = (972 + 2600 – 438 + 438) – (953-211+211) -262

PTA = ***at least 2357 days*** (until January 1, 2013 and continuing up to issuance).

4. This Patent Is Not Subject To A Terminal Disclaimer

5. The Term Of This Patent Should Be Adjusted

Applicant requests reconsideration of the Patent Term Adjustment ("PTA") for this application as detailed above. Applicant submits that the PTA should be calculated under the

rationale of the *Exelixis* decision, which results in a total patent term adjustment of ***2357 days*** up to January 1, 2013 and continuing to accumulate until issuance.

Respectfully submitted,

Date: January 18, 2013 By: /Richard A. Nebb/
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encl. Exhibit A: Spreadsheet of PTO calculation
Exhibit B: Spreadsheet of Applicant calculation
Exhibit C: December 10. 2008 Federal Register Notice

EXHIBIT A

PTO Calculation of
Patent Term Adjustment

No.	Date		A Delay	B Delay	C Delay	App. Delay
17	11/19/2002	CPA				
28	2/28/2003	Non-Final Rejection				
32	7/31/2003	Response				64
35	10/27/2003	Non-Final Rejection				
38	4/30/2004	Response				94
42	8/13/2004	Non-Final Rejection				
47	1/18/2005	Response				66
52	6/6/2005	Final Rejection	19			
57	9/8/2005	Notice of Appeal				2
X	11/19/2005	3 years after CPA				
61	2/13/2006	Appeal Brief				
69	6/15/2006	Non-Final Rejection	2			
71	9/13/2006	Notice of Appeal				
82	7/2/2007	Decision on Pre-Appeal Review				
91	10/5/2007	Notice of Non-Compliant Amendment	265			
92	11/5/2007	Informal Amendment				
107	4/15/2008	Notice of Allowance	41			
112	7/9/2008	Withdraw Notice of Allowance				
115	9/17/2008	Non-Final Rejection				
120	12/9/2008	Response				
122	12/12/2008	Notice of Appeal				
127	12/30/2008	RCE				
136	7/1/2009	Non-Final Rejection	83			
137	10/1/2009	Response				
142	1/21/2010	Final Rejection				
143	2/12/2010	Notice of Appeal				
150	6/9/2010	Appeal Brief				
154	8/6/2010	IDS				58
158	10/13/2010	Answer I				
167	12/13/2010	Reply Brief				
183	7/12/2011	Answer II	276			
185	9/12/2011	Reply Brief II				
189	9/13/2011	Petition				
188	9/27/2011	Errata Sheet re Reply II				
208	2/24/2012	BPAI Decision			743	
256	10/18/2012	Notice of Allowance				
	??	Patent Issues				
Total			**686**	**0**	**743**	**284**

A.delay + C.delay - App.delay = 686 + 743 - 284 = 1145

EXHIBIT B

Applicant Calculation of
Patent Term Adjustment

PAIR No.	Date		A Delay	B-3 B Delay 1st RCE	B-2 B Delay 2nd RCE	B-1 B Delay exelixis	C Delay	App. Delay
17	11/19/2002	CPA						
28	2/28/2003	Non-Final Rejection						
32	7/31/2003	Response						64
35	10/27/2003	Non-Final Rejection						
38	4/30/2004	Response						94
42	8/13/2004	Non-Final Rejection						
47	1/18/2005	Response						66
52	6/6/2005	Final Rejection	19					
57	9/8/2005	Notice of Appeal						2
X	11/19/2005	3 years after CPA						
61	2/13/2006	Appeal Brief						
69	6/15/2006	Non-Final Rejection	2					
71	9/13/2006	Pre-Brief Conference Request						
82	7/2/2007	Decision on Pre-Appeal Review						
91	10/5/2007	Notice of Non-Compliant Amendment						
92	11/5/2007	Informal Amendment						
107	4/15/2008	Notice of Allowance						
112	7/9/2008	Withdraw Notice of Allowance						
115	9/17/2008	Non-Final Rejection	613					
120	12/9/2008	Response						
122	12/12/2008	Notice of Appeal						3
127	12/30/2008	RCE		1137				18
136	7/1/2009	Non-Final Rejection	62					
137	10/1/2009	Response						
142	1/21/2010	Final Rejection						
143	2/12/2010	Notice of Appeal						
150	6/9/2010	Appeal Brief						
154	8/6/2010	IDS						
158	10/13/2010	Answer I						
167	12/13/2010	Reply Brief (start C delay)						
183	7/12/2011	Answer II	276					
185	9/12/2011	Reply Brief II						
189	9/13/2011	Petition						
188	9/27/2011	Errata Sheet re Reply II						15
208	2/24/2012	BPAI Decision					438	
238	09-17-2012	RCE			2056			
256	10/18/2012	Notice of Allowance						
	1/1/2013					2600		
	??	Patent Issues						
Total			**972**	**1137**	**2056**	**2600**	**438**	**262**

EXHIBIT C

possess, carry, and transport concealed, loaded, and operable firearms within a national wildlife refuge in accordance with the laws of the state in which the wildlife refuge, or that portion thereof, is located, except as otherwise prohibited by applicable Federal law.

Dated: December 5, 2008.

Lyle Laverty,

Assistant Secretary of the Interior for Fish and Wildlife and Parks.

[FR Doc. E8-29249 Filed 12-9-08; 8:45 am]

BILLING CODE 4312-52-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 41

[Docket No.: PTO-P-2007-0006]

RIN 0651-AC12

Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule; delay of effective and applicability dates.

SUMMARY: On June 10, 2008, the United States Patent and Trademark Office (Office) published the final rule that amends the rules governing practice before the Board of Patent Appeals and Interferences (BPAI) in *ex parte* patent appeals. The final rule states that the effective date is December 10, 2008, and that the final rule shall apply to all appeals in which an appeal brief is filed on or after the effective date. On June 9, 2008, the Office published a 60-Day **Federal Register** Notice requesting the Office of Management and Budget (OMB) to establish a new information collection for BPAI items in the final rule and requesting public comment on the burden impact of the final rule under the provisions of the Paperwork Reduction Act (PRA). On October 8, 2008, the Office published a 30-Day **Federal Register** Notice stating that the proposal for the collection of information under the final rule was being submitted to OMB and requesting comments on the proposed information collection be submitted to OMB. The proposed information collection is currently under consideration by OMB. Since the review by OMB has not been completed, the Office is hereby notifying the public that the effective and applicability date of the final rule is not December 10, 2008. The effective and applicability dates will be identified in a subsequent notice.

DATES: The effective date for the final rule published at 73 FR 32938, June 10, 2008, is delayed, pending completion of OMB review of the proposed information collection under the PRA. The Office will issue a subsequent notice identifying a revised effective date on which the final rule shall apply.

FOR FURTHER INFORMATION CONTACT: Allen MacDonald, Administrative Patent Judge, at (571) 272-9797, or Kimberly Jordan, Chief Trial Administrator, at (571) 272-4683, Board of Patent Appeals and Interferences, directly by phone, or by facsimile to (571) 273-0043, or by mail addressed to: Mail Stop Board of Patents Appeals and Interferences, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: On June 10, 2008, the United States Patent and Trademark Office (Office) published the final rule that amends the rules governing practice before the Board of Patent Appeals and Interferences (BPAI) in *ex parte* patent appeals. *See Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals;* Final Rule, 73 FR 32938 (June 10, 2008), 1332 *Off. Gaz. Pat. Office* 47 (July 1, 2008) (hereinafter "BPAI final rule 2008"). The BPAI final rule 2008 states that the effective date is December 10, 2008, and that the final rule shall apply to all appeals in which an appeal brief is filed on or after the effective date.

On June 9, 2008, the Office published a new information collection request for OMB to review several BPAI items in the BPAI final rule 2008 as subject to the PRA. *See Board of Patent Appeals and Interferences Actions;* New Collection, Comment Request, 73 FR 32559 (June 9, 2008) (hereinafter "60-Day Notice"). In addition to requesting OMB to establish a new information collection, the 60-Day Notice invited comments from the public and other Federal agencies on the burden impact of the proposed information collection under the provisions of the PRA. The 60-Day Notice specified that comments were to be submitted on or before August 8, 2008.

On October 8, 2008, the Office published a notice that the proposed information collection was being submitted to OMB and public comments on the proposed collection were to be submitted to OMB on or before November 7, 2008. *See Submission for OMB Review; Comment Request:* 73 FR 58943 (October 8, 2008) (hereinafter "30-Day Notice"). On October 9, 2008, the Office filed a Supporting Statement with OMB (*http://www.reginfo.gov/public/do/PRAViewDocument?ref_nbr=200809-0651-003*). The Supporting Statement included the Office's response to comments received following the 60-Day Notice. The 30-Day Notice requested public comments be submitted to OMB on or before November 7, 2008.

The proposed information collection request is currently under consideration for approval by OMB. The review by OMB has not been completed. Therefore, the effective and applicability dates of the BPAI final rule 2008 will not be December 10, 2008. The Office will notify the public when the revised effective and applicability dates are set. In the subsequent notification, the Office will provide at least a 30-day time period before the BPAI final rule 2008 becomes effective.

On November 20, 2008, the Office published a clarification notice on the effective date provision. *See Clarification of the Effective Date Provision in the Final Rule for Ex Parte Appeals,* 73 FR 70282 (November 20, 2008). As indicated in the clarification notice, the Office will not hold an appeal brief as non-compliant solely for following the new format even though it is filed before the effective date. Thus, appeal briefs filed before the effective date of the BPAI final rule 2008 (yet to be determined) must either comply with current 37 CFR 41.37 (which remains in effect) or revised 37 CFR 41.37 (the effective date of which has yet to be determined). Furthermore, the Office has posted a list of questions and answers on the USPTO Web site (at *http://www.uspto.gov/web/offices/dcom/bpai/rule.html*) regarding the implementation of the BPAI final rule 2008. These questions and answers will be revised accordingly.

Dated: December 5, 2008.

Jon W. Dudas,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. E8-29297 Filed 12-9-08; 8:45 am]

BILLING CODE 3510-16-P

ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 180

[EPA-HQ-OPP-2007-0672; FRL-8390-8]

Mefenpyr-diethyl and Metabolites; Pesticide Tolerance

AGENCY: Environmental Protection Agency (EPA).

ACTION: Final rule.